

P25226.A04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Gennadi FINKELSHTAIN et al. Confirmation No. 5961
Appl. No. : 10/849,503 Group Art Unit: 1795
Filed : May 20, 2004 Examiner: M. S. Siddiquee
For : DISPOSABLE FUEL CELL WITH AND WITHOUT CARTRIDGE
AND METHOD OF MAKING AND USING THE FUEL CELL AND
CARTRIDGE

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Amendment
Randolph Building
401 Dulany Street
Alexandria VA 22314

Sir:

In response to the Examiner's restriction requirement of August 21, 2008, the time set for response being one month, i.e., September 22, 2008 (September 21, 2008 being a Sunday), Applicant hereby elects the invention of Group I and Species "a" directed to at least claims 1-34 with traverse.

In the instant Official Action, the Examiner indicated that all claims (i.e., claims 1-123) were subject to restriction under 35 U.S.C. § 121. The Examiner restricted the claimed invention into Group I, including 1-34, 72-110 and 118-123, drawn to Disposable fuel cell system, classified in class 429, subclass 34, Group II, including claims 35-53, drawn to Method of assembling a cartridge to a fuel cell, classified in class 29, subclass 592.1, Group II, including claims 54-71, drawn to Cartridge, classified in class 220, subclass 530, Group IV, including claims 111-117, drawn to Method of filing a fuel cell, classified in class 429, subclass 17.

The Examiner also asserted an election of species requirement wherein if Applicant elects the invention of Group I, one of the following species must be elected: (a) Disposable fuel cell with cartridge and non-refillable mechanism (claims 1-34); (b) Disposable fuel cell without cartridge (claims 72-90); (c) Disposable fuel cell with cartridge having integral valves (claims 91-110); and (d) Disposable fuel cell with non-refillable mechanism (claims 118-123).

The Examiner asserted that the above-noted inventions of Groups I – IV were distinct from each other under M.P.E.P. §§ 802.01, 806.06, 806.05(c), 806.05(e). In addition to the restriction, the Examiner, while asserting that no claims are generic, indicated that if Group I is elected, an election of one of above-noted four species (a) – (d) would also be required under 35 USC Section 121.

Applicant respectfully submits that the instant restriction requirement is improper at least because the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

While the Examiner has alleged possible distinctions between the identified groups of invention, the Examiner has not shown that a concurrent examination of Groups I – IV, and each species, would present a "serious burden." In fact, the Examiner has failed to specify any appropriate statement that the search areas required to examine the invention of Group I would not overlap into the search areas for examining the invention of Groups II-IV, and vice versa.

Applicant respectfully submits that the search for the combination of features recited in the claims of the above-noted groups, and the individual species, if not totally co-extensive, would

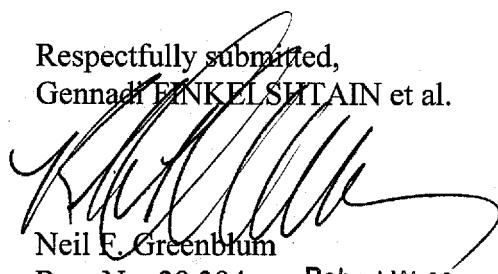
P25226.A04

appear to have a substantial degree of overlap. Indeed, the Examiner has acknowledged that the inventions of at least Groups I and IV are classified in the same class, i.e., class 429. Because the search for each group and species of invention is apparent substantially the same (for purposes of examination), Applicant submits that no undue or serious burden would be presented in concurrently examining Groups I-IV (including each identified species). Thus, for the above-noted reasons, and consistent with the Office policy set forth above in M.P.E.P. § 803, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction and species requirement in this application.

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicant has elected, with traverse, the invention defined by the Examiner as Group I, directed to claims 1-34, 72-110 and 118-123, and Species "a" upon which at least claims 1-34 are readable, in the event that the Examiner chooses not to reconsider and withdraw the restriction and/or species requirement. As such, at least claims 1-34 are ready for examination.

Please charge any additional fees necessary for consideration of the papers filed herein and refund excess payments to Deposit Account No. 19-0089.

Respectfully submitted,
Gennadi FINKELSHTAIN et al.


Neil E. Greenblum
Reg. No. 28,394

Robert W. Mueller
Reg. No. 35,043

September 22, 2008
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191
{P25226 00534329.DOC}